

REMARKS

I. STATUS OF CLAIMS

Claims 1-20 are pending in the application. Of these claims, claims 13-20 have been withdrawn from consideration by the Examiner's restriction requirement. After entry of the above amendments, Claims 1-12 and 21-28 are pending in the present Application. In the above amendments, Claims 1 and 24 were amended, and Claims 25-28 were added. No new matter is involved.

Claims 1, 4, 5, 7, 9, 11, and 21 were rejected in the Office Action under 35 U.S.C. §102(b) ("Section 102(b)") as being anticipated by Otake (JP2000-201545), (hereinafter referred to as "Otake").

Claims 2, 3, 6, 8, and 10 are rejected under 35 U.S.C. §103(a) ("Section 103(a)") as being unpatentable over Otake in view of DiMuzio (US 6,237,882), (hereinafter referred to as "DiMuzio").

Claim 12 is rejected under Section 103(a) as being unpatentable over Otake in view of Pierce (US 4,190,984), (hereinafter referred to as "Pierce").

Claims 22 and 23 are rejected under Section 103(a) as being unpatentable over Otake (JP2000-201545) in view of Pan (US 6,237,882 B1).

Claim 24 is rejected under Section 103(a) as being unpatentable over Otake (JP2000-201545) in view of Bales (US 4,258,503).

Applicant respectfully traverses all rejections and requests reconsideration.

A. REJECTION UNDER SECTION 102(b), OTAKE

The Examiner rejected claim 1 under Section 102 as being anticipated by Otake. Claim 1 has been amended and is no longer anticipated by Otake. Otake describes a sphagnum topiary structure having an opening for a hand to fit through with a door (Otake, Abstract, par. 0006). The opening described by Otake only allows the user to place one hand into the 3-D structure to place sphagnum into the structure. (See Fig. 2 and claim 1). Further this necessitates that the plant be placed through the door into the frame. Otake teaches that the opening allows one to use his hands to better "pack" and "stuff" sphagnum.

(Otake, par. 0006). Applicant has explained this type of “sphagnum topiary” that “involves filling the frame with material” and requires one to wait for the plant to “mature and assume the shape of the topiary form” as a disadvantage to topiary making. (See Application page 5, line 19 and page 6, line 9). Hence, the teaching of Otake is precisely the problem that the present invention sets out to solve.

Claim 1, as amended, now recites the limitations that the topiary frame comprise “an aperture at a bottom of the topiary frame formed by bottom edges of at least two of the separable members when in a closed position”, “the aperture is parted open along the center axis” and “the main structure and aperture...enclose around a growing or grown plant without lifting a base of the plant or the plant from its base.” Support for such amendment is found in Applicant’s specification disclosing how an aperture 90 facilitates the placement of the topiary structure about a plant and how the interior side of the structure is placed about a growing or mature plant; where the frame can be instantly used with existing grown plants and the topiary frame is placed about a growing plant, allowing the plant to grow up through an aperture located at a bottom of the topiary frame. (See Application, page 8, paragraph 0027, lines 11-18, and pars. 0028-0029, Figs. 1 and 3).

Otake teaches away from the limitations of amended claim 1 of “an aperture at a bottom of the topiary frame” “the aperture is parted open along the center axis” and “without lifting a base of the plant or the plant from its base” by showing in Fig. 3 a plant lifted off of its base to be inserted in to the frame through the door on the back. The applicant’s claims provide for the topiary frame to “enclose around a growing or grown plant” such that the entire plant need not be moved into the frame, but rather the frame is enclosed around the plant. Otake fails to show an aperture at the bottom of the frame which is parted open along the center axis.

Otake also teaches away from such a type of topiary structure of a frame enclosing a growing plant in Applicant’s amended claim 1, by teaching the use of the sphagnum technique with their structure where material is hand filled into the frame (Otake, par. 0014). The frame in Otake does not disclose having “the interior side of the main structure...completely exposed allowing for the main structure to enclose around a growing plant”. Only a portion of the interior side of the main structure of Otake, in Fig. 1 is

exposed, as the opening 11 only exposes a small opening in the “back” of the structure (Otake, Fig. 1). Examiner also reads into this limitation, language that is not a part of the claim of “in that the structure is visible or open to view” (Office Action, page 2). However, amended claim 1 reads that “the *interior side*” is “completely exposed”, which is not the same as a structure being “visible or open to view”.

In addition, amendment claim 1 requires that “wherein the one or more clips when released enable one or more of the two or more separable members *to move upon a center axis*”. The structure shown in Otake does not disclose the separable members *moving upon* a center axis but rather the door member 12 is moving upon hinge 13 which is NOT on a center axis, but rather moving upon an axis removed from the center axis. (Otake, Fig. 1)

Accordingly, Otake does not anticipate amended claim 1. For the above reasons, Applicant respectfully submits that amended claim 1 is patentable over Otake.

Claims 4, 5, 7, 9, 11 and 21

Dependent claims 4, 5, 7, 9, 11 and 21 include all limitations of their respective base claim 1, now amended. Accordingly, Applicant respectfully submits that these dependent claims are all allowable for at least the same reasons as is amended claim 1. Furthermore, Applicant respectfully submits that these dependent claims are further allowable for the limitations that they themselves recite.

For example, dependent claim 21 recites that “the center axis is located at a halfway point of the main structure”. As mentioned with regard to claim 1, the separable members “move upon a center axis”. As such, the ‘horizontal axis’ Examiner described with regard to Fig. 1 of Otake is not a center axis of which the separable members “move upon”. The Otake door 12, does not move upon a horizontal axis, but rather a vertical axis that is not located halfway on the structure in Otake.

Applicant respectfully disagrees with the assertions regarding the dependent claims from the Office Action. The assertions have been made moot by the above discussion of the base claim.

For the above reasons, Applicant respectfully requests withdrawal of the rejection of Claims 4, 5, 7, 9, 11 and 21 under Section 102(b).

B. REJECTION UNDER SECTION 103(a), OTAKE IN VIEW OF DIMUZIO

Claims 2, 3, 6, 8 and 10 were rejected under Section 103(a) as obvious over Otake in view of DiMuzio. Applicant respectfully traverses Examiner's rejection as explained below.

As explained in M.P.E.P. Section 706.02(j):

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The three above-mentioned criteria must exist at the time the claimed invention was made, according to the text of Section 103(a) itself. The Examiner has not established a prima facie case of obviousness for at least the reasons stated below.

Claims 2, 3 and 6 all depend from its base claim, independent amended claim 1. As amended, claim 1 requires the limitation that the topiary frame comprise "an aperture at a bottom of the topiary frame formed by bottom edges of at least two of the separable members when in a closed position" which is "parted open along the center axis upon the one or more hinges" and to "enclose around a growing or grown plant without lifting a base of the plant or the plant from its base,." Such limitations are nowhere provided by the combination of Otake with DiMuzio. In addition, neither are the limitations of "wherein the one or more clips when released enable one or more of the two or more separable members *to move upon a center axis*" and "pivot or rotate along their one or more hinges such that the interior side of the main structure is completely exposed". As mentioned above, the deficiencies of Otake have been discussed in connection with amended claim 1. DiMuzio simply does not supply the deficiencies of Otake. Accordingly, Applicant respectfully submits that claims 2, 3 and 6 are allowable for at least the same reasons as is amended claim 1.

In rejecting claim 8, the Examiner cites to element 20 from Figure 14 of DiMuzio. (See Fig. 14 and col. 4 lines 11-21). Element 20 of DiMuzio is described as "corkscrew

shaped pins.” (See col. 4 lines 6-7). An actual fruit, vegetable, or candle can be mounted to the threaded corkscrew. (See col. 4 lines 11-21). However, Applicant recites in amended claim 8, which depends from the limitations of amended claim 7 that the “objects” corresponding to the “upper and lower extremity set of members” are “for enclosing topiary foliage” and having a “three-dimensional unitary form”. Thus, while DiMuzio describes having actual fruits attached to the topiary, these fruits are not part of any “three-dimensional unity form” of the “topiary frame”; in fact, the cited element 20 is a pin, which is in no manner “for enclosing topiary foliage”. As such, DiMuzio does not disclose a topiary frame comprising objects “for enclosing topiary foliage” but rather teaches that actual fruits, which are not part of the frame, are attached independently to “pins” on the frame.

In addition, claim 8 further incorporates the base limitations of amended claim 1, and as mentioned, DiMuzio does not supply the deficiencies of Otake. Accordingly, Applicant respectfully requests that amended claim 8 is allowable for at least the same reasons as is amended claim 1.

In rejecting claim 10, the Examiner stated that the limitations of claim 8 are disclosed by DiMuzio and that a

“bear design with fruit etc. was an art-recognized equivalent to a seal and ball in animal-from topiaries where in is immaterial as the exact animal form, it would have been obvious to one of ordinary skill in the art at the time the invention to substitute the bear/fruit with the seal/ball in the topiary of Otake as modified by DiMuzio.”(Office Action, page 4).

However, Applicant disagrees with the Examiner’s assertion, because no where is there any suggestion of a bear with fruit, especially because as discussed above, the fruit of DiMuzio is actual fruit mounted to protrusions, threaded corkscrews, and in no manner a part of the three-dimensional unitary form of the topiary frame for “enclosing topiary foliage” as required in claim 10. Furthermore, neither does DiMuzio provide for all the claim limitations of claim 10, as it is ultimately dependent upon the limitations of amended claim 1, which are deficient in Otake as discussed above.

Accordingly, Otake in view of DiMuzio fail to teach or suggest ALL claim limitations as required to establish a prima facie case of obviousness. Accordingly,

Applicant respectfully requests withdrawal of the rejections of Claims 2, 3, 6, 8 and 10 under Section 103(a).

C. REJECTION UNDER SECTION 103(a), OTAKE IN VIEW OF PIERCE

Claim 12 depends on and includes all limitations of its respective base claim 1. The deficiencies of Otake have been discussed above in connection with amended claim 1. Pierce simply does not supply the deficiencies of Otake, in particular, the limitations of "wherein the one or more clips when released enable one or more of the two or more separable members to move upon a center axis and pivot or rotate along their one or more hinges such that the interior side of the main structure is completely exposed" and "allowing for the main structure to enclose around a growing or grown plant without lifting a base of the plant or the plant from its base.." Accordingly, Applicant respectfully submits that claim 12 is allowable for at least the same reasons as is amended claim 1 and requests withdrawal of the rejection of claim 12 under Section 103(a).

D. REJECTION UNDER SECTION 103(a), OTAKE IN VIEW OF PAN

Claims 22-23 depend on and include all limitations of their respective base claims 1 and 7. The deficiencies of Otake have been discussed above in connection with amended claim 1. Pan simply does not supply the deficiencies of Otake, in particular, at least the limitation of the topiary frame in its open position "to enclose around a growing or grown plant such that the plant need not be lifted from its base.." Accordingly, Applicant respectfully submits that claims 22-23 are allowable for at least the same reasons as is amended claim 1 and requests withdrawal of the rejection of claims 22-23 under Section 103(a).

E. REJECTION UNDER SECTION 103(a), OTAKE IN VIEW OF BALES

Claim 24 provides for a number of similar limitations as discussed above with regard to amended claim 1. Claim 24 has also been amended to require that the symmetrical separable members of the main structure are operable in positioning around a

grown plant “without lifting a base of the plant or lifting the plant from its base”. In addition, the claim has been amended to comprise “an aperture at a bottom of the frame formed by bottom edges of at least two of the separable members when in a closed position”. The deficiencies of Otake have been discussed above. Bales simply does not supply the deficiencies of Otake, in particular, at least the limitation of the topiary frame in its open position “for positioning around a grown plant without lifting a base of the plant or lifting the plant from its base. ” In addition, Bales fails to show “an aperture at a bottom of the frame formed by bottom edges of at least two of the separable members when in a closed position” and neither the “aperture is parted open” when the two symmetrical separable members “pivot or rotate along their one or more hinges”. Furthermore, Bales teaches away from a maneuverable topiary frame having “two symmetrical separable members of the main structure are sufficiently opened *for positioning around a grown plant* “. Rather, Bales teaches that the structure is “filled with a medium capable of retaining moisture, such as moss, for example. Living plants are rooted into the medium”. (Bales, col. 1, lines 15-18). Therefore, plant material is placed inside the moss of the Bales structure; Bales in no manner discloses that symmetrical members are “opened for positioning around a *grown plant*” and teaches otherwise. Applicant respectfully submits that claim 24 is allowable for at least the same reasons as is amended claim 1 and requests withdrawal of the rejection of claim 24 under Section 103(a).

F. NEW CLAIMS 25-28

New claims 25-28 have been added to claim the invention more extensively without adding new matter. Support for claim 25 is found in Applicant’s Figure 4 which shows the plant foliage filling a majority of the inside volume of the frame. Support for the remaining claims are found through the application description which describes how the topiary frame is used for creating topiaries. Applicant respectfully submits that the new claims are allowable over the cited at least for reasons similar to those by which amended claim 1 is allowable over the cited art. Otake, DiMuzio, Pierce, Pan and Bales are dedicated to their achieving their own respective goals, as discussed above, and simply do not teach or even

suggest the elements of new claims 25-28. Accordingly, Applicant respectfully submits that new claims 25-28 are allowable.

II. CONCLUSION

The above-discussed amendments and remarks are believed to place the present Application in condition for allowance. Should the Examiner have any questions regarding the above amendments, the Examiner is requested to telephone Applicant's representative at the number listed below.

Respectfully submitted,

Date: 10/11/2005



Otto O. Lee (Reg. No.: 37,871)
Juneko Jackson (Reg. No.: 48,870)
Marie Grace Capuyan (Reg. No.: 52,695)
Intellectual Property Law Group LLP
Attorneys for Applicant

Atty Docket No.: SK703.PT1
Contact No.: 408-286-8933